

**REMARKS**

Claims 44-58 are now in this application. Claims 1-43 are rejected. Claims 1-43 are canceled herein, and new claims 44-58 are substituted therefor.

Applicant herein traverses and respectfully requests reconsideration of the rejection of the claims cited in the above-referenced Office Action.

The applicant and applicant's attorney appreciate the Examiner's granting of the telephone interview conducted on December 16, 2003, and extend their thanks to the Examiner the Examiner's Supervisor for their time and consideration. The newly added claims were drafted in consideration of the discussions had during the interview as relating to the prior art currently cited in the rejections of claims 1-43.

Claims 1-8, 10, 12-16, 18-21 and 30-43 are rejected as obvious over Sizer et al. (US 5,923,252) in view of Frey (US 5,138,638) under 35 U.S.C. §103(a). Claims 9, 11 and 17 are rejected as obvious over Sizer et al. (US 5,923,252) in view of Frey (US 5,138,638), and further in view of Fraser (US 5,620,061) under 35 U.S.C. §103(a). Claims 22-26, 28 and 29 are rejected as obvious over Frey (US 5,138,638) in view of Sizer et al. (US 5,923,252) under 35 U.S.C. §103(a). Claim 27 is rejected as obvious over Frey (US 5,138,638) in view of Sizer et al. (US 5,923,252), and further in view of Fraser (US 5,620,061) under 35 U.S.C. §103(a). Claims 1-43 are now canceled, rendering the rejection moot. However, insofar as the subject matter of new claims 44-58 reflects that of the cancelled claim, and in the event the

Examiner considers asserting the present rejection against the new claims, applicant submits the following remarks.

The Sizer et al. reference teaches a message delivery device which selectively delivers a message only to a person who has shown an interest in a particular product which is displayed. The reference states in unequivocal terms that the presentation of a message indiscriminately to any and all individuals in the vicinity of a displayed product is considered to be unacceptable to practice of the invention. "Detection is not sufficient on its own to cause delivery of the message. If this were the case the message would be delivered to people who were perhaps not interested in the product." (See col. 2, lines 44-51). The invention instead mandates that a message will only be presented to a person who performs a particular action which demonstrates an interest on the part of that person for the associated product, such providing a message only to a person opening a refrigerator door in a wine shop. Therefore, while the prior art referred to in the background section of Sizer et al. is allegedly said to teach the detection of a person in a vicinity of a product and delivery of a message to that person irrespective of the persons interest in the product, one of ordinary skill in the art, having read the Sizer et al. reference, would think that presentation of a message to a person which was not qualified on an actual prior expressed interest in a product on display was to be considered undesirable, and not to be incorporated into a message delivery system.

Frey is cited by the Examiner to provide what is admittedly absent from Sizer et al., i.e., the detection of potential customers in a range by counting in direct sequence persons passing by sensors at an entry an exit to determine a number of potential customers in the range at a given time. The Frey reference is directed to a system used in analyzing conversion rate of shoppers to actual customers. As explained in the background section of Frey, the conversion rate was conventionally determined by counting all persons in a store during a particular period of time, and comparing this number to the number of actual purchases. The reference seeks to improve such approach by providing a means for distinguishing shoppers and non-shoppers from a general population in the store based upon selected criteria, such as height categories. In accordance with the disclosed system, for example, only persons over a certain height who pass a store location, such as an doorway, are counted as shoppers, and the remaining persons are considered non-shoppers, such as, for example, children and shopping carts. As such, Frey claims that a more accurate measure of the conversion rate is made possible.

Applicant submits that one of ordinary skill would not arrive at the presently claimed invention by combining the Sizer et al. reference with Frey for the following reasons. In order to establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. The Examiner has argued that, in accordance with

the prior art referred to in Sizer et al., messages were presented to everyone passing by a product irrespective of his/her interest in the product. However, such statement fails to acknowledge that the Sizer et al. reference also expressly rules out such prior art approach as unacceptable. In accordance with its disclosure, the feature, by which a message is to be presented exclusively to a person who performs a particular action which demonstrates an interest on the part of that person for the associated product, is to be considered essential to practice of the invention therein. Therefore, not only does the Sizer et al. reference fail to provide motivation to one skilled in the art to ignore the mandates of the disclosure and to deliver a message to all individuals passing by a product, but it further specifically teaches away from such approach by expressly advising against the wholesale dissemination of messages to all persons. It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art. *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 230 USPQ 416, 420 (Fed. Cir. 1986) citing *In re Wesslau*, 353 F2d 238, 241, 147 USPQ 391, 393 (CCPA 1965). Therefore, consideration must properly be given to teachings of the prior art which would lead one away from the claimed invention as well as those that might suggest the invention. *Mendenhall v. Astec Industries, Inc.*, 13 USPQ2d 1913, 1939 (Tenn 1988), *aff'd*, 13 USPQ2d 1956 (Fed. Cir. 1989). In the present case, one skilled in the art would not consider it

advisable to disseminate information via a message to individuals absent some prior expressed interest, based upon a reading of Sizer et al..

In addition, even if the prior art approach mentioned in the background section of Sizer et al. were to be properly combined with the teachings of Frey, applicant submits that one of ordinary skill in the art would still not be lead to the present invention. While it remains applicant's position that the paucity of description in Sizer relating to the prior art approach to message delivery would make practice of conventional system and method impossible without requiring undue experimentation, thereby failing to provide enabling disclosure therefore, the disclosure appears on its face, for example at col. 56-64, to teach a method in which the presence of a person is detected when in a vicinity of a product and a message is delivered indiscriminately to that person relating to the product. According to this understanding of the conventional art referred to in Sizer et al., a message relating to a particular product is given to an individual based upon a proximity of the individual to a displayed product. Others present in a range, such a room or store, in which the product is on display, and who are not in the vicinity of the product, and whose presence is therefore not detected, do not trigger the delivering of the message, and presumably these individuals do not necessarily receive the contents of the message directed to the individual near the product whose presence is detected. Thus, the message is "product-bound", i.e., is given only to that person detected as present near the product itself. Such product-bound relationship is not

required by independent claims 44 and 52 of the present invention. In addition, display of the products in accordance with claims 51, 53 and 58 is in a range entirely separate and distinct from the advertizing range, and these products (or services) are presented to customers only after they have been given the messages.

Neither Frey nor Sizer et al. contain teaching or suggestion to present an advertizing message to all persons within a range directed to a particular product or service and then to subsequently compare the number of these individuals to another number representing a portion of these individuals who actually purchase the product or service to which the presented advertising message was directed. Therefore, the proffered combination of references could not possibly teach all claim limitations as properly required for establishing a *prima facie* case of obviousness. Frey merely teaches, that from a true measure of number of customers in a store, it is possible to determine how various in-store promotions and competitors' advertising affects a store's performance. For example, if the store runs a sale, or a competitor advertises a special promotion, the stores attendance overall is gauged against such factors. This can be used to establish a measure of store performance (col. 3, lines 27-35), but not the effectiveness of an in-store advertisement delivered to an entire measured population present as indicative of customer behavior in relation to the advertising presented by the projected messages. The reference fails, therefore, to relate a particular in-store advertisement presented to a total of individuals in a range, to the

advertisement's effectiveness in generating sales of product or service related to the advertisement, as presently claimed.

Applicant respectfully submits that Sizer et al. fails to adequately supplement this lacking disclosure. In particular, by showing an advertisement only to a person interested in the product, or at the very least (according to the background art) to a person detected near a product irrespective of interest, the effectiveness of an advertising message cannot be ascertained by relating a number of all persons in a range who receive such message to a subsequent measure of a total number of customers who purchase the advertised items after receiving the advertisement. Thus, if one skilled in the art were to combine the teachings of Frey and Sizer et al., while a total number of individuals could be determined at a particular time, not all of the individuals counted as present in the range would necessarily receive the message related to the advertised product, and therefore it would be impossible to determine which of the people in the range who were subsequently buying the product were doing so because of receiving the presented message. The presently claimed invention, in stark contrast, allows such comparative analysis, and is therefore not made obvious by the cited references discussed above.

Regarding the Fraser reference, which is offered for its teaching regarding fiber optical displays, it is applicant's position that the teaching contained therein fails to provide what is missing in the Frey and Sizer et al. references, as discussed in detail above.

Based upon the foregoing, applicant submits that newly added claims 44-58 are patentable over the cited art presently of record, and allowance of the claims is earnestly solicited.

Applicant respectfully requests a two (2) month extension of time for responding to the Office Action. Please charge the fee of \$210 for the extension of time to Deposit Account No. 10-1250.

In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited. Please charge any deficiency or credit any overpayment to Deposit Account No. 10-1250.

Respectfully submitted,  
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